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EXAMINER

RAMAKRISHNAIAH, MELUR

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2643

12

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Paper No. 12

Application Number: 10/042,428

Filing Date: 10-24-2001

Appellant(s): Kenneth J. Cool

Mailed

OCT 08 2003

Technology Center 2600

Bradley A. Forrest

For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 6-30-2003.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

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(2) *Related Appeals and Interferences*

None

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is deficient because it is not a summary of the appellant's invention, but rather a description of his drawings. The real summary of the invention is shown on pages 1 and 2 of the Appellant's specification and the Board's attention is respectfully directed to pages 1 and 2 of the appellant's specification for a correct summary of the invention..

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims Group 1: Claims 1-3, 10-13, 20-21, 22-23, and 25-30, the claims in this group do stand or fall together; Group 2: Claims 4,6-9, 14, 16-19, the claims in this group stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) *Claims Appealed*

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The copy of appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

| | | |
|----------------|--------------------|---------|
| ✓ 6,141,058 | Lagoni et al. | 10/2000 |
| ✓ 5,706,388 | Isaka | 1/1998 |
| ✓ 5,241,428 | Goldwasser et al. | 8/1993 |
| JP02001028645A | Natori et al. | 1/2001 |
| ✓ JP306319173A | Tsutsumi | 11/1994 |
| ✓ 6,324,270 B1 | Lund | 11/2001 |
| ✓ JP403178247A | Shimada et al. | 8/1991 |
| ✓ JP404112374A | Tamura et al. | 4/1992 |
| ✓ WO 99/35831 | Schultheiss et al. | 7/1999 |

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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2. Claims 1-3, 12, 13, 20, 21, 22, 27-30, are rejected under 35 U.S.C. 103(a) as being unpatentable over Lagoni et al. (US PAT: 6,141,058, hereinafter Lagoni) in view of Isaka (US PAT: 5,706,388) and Goldwasser et al. (US PAT: 5,241,428, hereinafter Goldwasser).

Regarding claim 1, Lagoni discloses a system for uninterrupted viewing of a real time program during a telephone call to a user comprising: a display capable of displaying caller identification data upon receipt of the call (col. 4 lines 4-9), a controller (110, fig. 1) capable of detecting acceptance and termination of the call by the user (col. 4 lines 10-17, also see step 530, fig. 5).

Regarding claims 12-13, and 20, Lagoni further discloses a system for providing uninterrupted viewing of a real time program during a telephone from a caller to a user, the system comprising: means for displaying caller identification information upon receipt of a call (col. 4 lines 4-9), means (110, fig. 1) for detecting acceptance and termination of the call by the user (col. 4 lines 10-17, also see step 530, fig. 5).

Regarding claims 21-22, Lagoni further discloses an integrated system for providing for providing uninterrupted viewing of a real time program during a telephone from a caller to a user, comprising: a display in (158, fig. 1) capable of displaying the program and caller identification information upon receipt of the call (col. 4 lines 4-9), a speaker (136, fig. 1) capable of audio output for the program and the call (51-53), a microphone (not shown) capable of accepting audio input for the call, a user input device (125, fig. 1) for controlling the viewing of the program (col. 4 lines 41-43, col. 5 lines 61-63) and for accepting and terminating the call, controller (110, fig. 1) capable of detecting and termination of the call by the user (this step is implicit in view of step 530 in fig. 5).

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Lagoni differs from claims 1, 12, 13, 20-22 in that he does not teach the following: a buffer coupled to the controller, wherein the buffer is capable of buffering the real-time program from the acceptance of the call and providing buffered program to the user upon the termination of the call until the buffered program coincides with the real-time program.

However, Isaka discloses recording system which teaches the following: : a buffer coupled to the controller, wherein the buffer is capable of buffering the real-time program from the acceptance of the call and providing buffered program to the user upon the termination of the call (fig. 1, col. 3 lines 4-36) and Goldwasser discloses variable-delay recorder which teaches the following: providing buffered program to the user upon the termination of the call until the buffered program coincides with the real-time program.(col. 2 lines 65-68, col. 3 lines 1-5).

Thus, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify Lagoni's system to provide for the following: a buffer coupled to the controller, wherein the buffer is capable of buffering the real-time program from the acceptance of the call and providing buffered program to the user upon the termination of the call until the buffered program coincides with the real-time program as this arrangement would facilitate the user to accommodate temporary interruptions to the program being watched to take a telephone call and still catch up with the program after the telephone call is finished as taught by Isaka and Goldwasser, thus providing enhancements to the Lagoni's system.

Regarding claims 2-3, 27-30, Lagoni further teaches the following: display coupled to the buffer and further capable of displaying buffered program to the user (fig. 3, col. 4 lines 33-43), means (158, fig. 1) for displaying caller identification data from the incoming telephone call to assist

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the user in selecting whether to answer the incoming phone call, detecting means (110, fig. 1) further comprises displaying caller identification data from the incoming phone call when the caller identification data matches a predetermined list, the caller identification data displaying means otherwise not displaying the caller identification data, displaying caller identification data from the incoming phone call to assist the user in selecting whether to answer the incoming phone call, displaying caller identification data matches a predetermined list, the displaying means otherwise not displaying the caller identification data (fig. 5, col. 4 lines 55-67, col. 5 lines 1-18).

3. Claim 4, 6-9, 14, 16-19, are rejected under 35 U.S.C. 103(a) as being unpatentable over Lagoni in view of Isaka and Goldwasser as applied to claim 1 above, and further in view of Natori et al. (JP02001028645A, hereinafter Natori)

Regarding claims 4 and 14, the combination teaches the following: a memory for storing data about the call, the data including the caller identification data about the call (col. 4 lines 64-67 of , '058); but it does not teach storing the length of the call.

However, Natori discloses information device which teaches storing length of call (see abstract).

Thus, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify the combination to provide for storing length of call as this arrangement would provide call history for the user for referencing it when required as taught by Natori.

Regarding claims 6-9 and 16-19, the combination teaches the following: capable of storing a caller list, the caller list being generated based on the stored data about the call, caller included in the caller list if the stored data about the call indicates that at least a predetermined percentage of the

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caller's call were accepted by the user (this is implied by the priority caller list, note: col. 4 lines 19-32), caller identification is displayed only if the caller is included in the caller list, automatically accepting the call if the caller is included in the caller list (col 2 lines 1-9).

4. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lagoni in view of Isaka and Goldwasser as applied to claim 1 above, and further in view of Tsutsumi (JP406319173A).

Regarding claim 10, the combination does not explicitly teach the following: input device for controlling viewing of the program and for accepting and terminating the caller by the user.

However, Tsutsumi discloses a remote controller serving as a telephone set which teaches the following: input device (3, fig. 1) for controlling viewing of the program and for accepting and terminating the caller by the user (see abstract).

Thus, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify the combination to provide for the following: input device for controlling viewing of the program and for accepting and terminating the caller by the user as this arrangement would enable the user to answer the call without going to the place of handset by using the remote controller as taught by Tsutsumi.

5. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lagoni in view of Isaka and Goldwasser as applied to claim 1 above, and further in view of Lund (US PAT: 6,342,270 B1, filed 7-13-1998).

*check this page
with item 4
of Response*

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Regarding claim 11, the combination does not teach the following: controller is further capable of automatically muting audio associated with the program upon acceptance of the call by the user.

However, Lund discloses system and coordination of electronic devices which teaches the following: controller is further capable of automatically muting audio associated with the program upon acceptance of the call by the user (col. 2 lines 36-48).

Thus, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify the combination to provide for the following: controller is further capable of automatically muting audio associated with the program upon acceptance of the call by the user as this would enable the user to answer the telephone call without being distracted by television audio as taught by Lund.

6. Claims 25-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lagoni in view of Isaka and Goldwasser as applied to claim 22 above, and further in view of Shimada et al. (JP403178247A, hereinafter Shimada) and Tamura et al. (JP404112374A, hereinafter Tamura).

Regarding claims 25, the combination does not teach the following: voice mail system to handle incoming phone call in the event the user does not answer the incoming phone call.

However, Shimada discloses television communication equipment which teaches the following: voicemail system to handle incoming phone call in the event the user does not answer the incoming phone call (fig. 1, see abstract).

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Regarding claim 26, the combination does not teach the following: voice mail system being disposed in a location selected from a group consisting of: integrated within the recording means, and external to recording means.

However, Shimada discloses voicemail system integrated with in the recording means (11, fig. 1) and Tamura teaches voicemail system external to the recording means in (11, fig. 1).

Thus, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify the combination to provide for the following: voicemail system to handle incoming phone call in the event the user does not answer the incoming phone call as this arrangement would facilitate to record messages when user is unable to answer the call as taught by Shimada; voice mail system being disposed in a location selected from a group consisting of: integrated within the recording means, and external to recording means as this arrangement would facilitate storage facilities for messages at different locations to suite users requirements when the user is unable to answer the call as taught by Shimada and Tamura.

7. Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lagoni in view of Isaka and Goldwasser as applied to claim 22 above, and further in view of Schultheiss et al. (WO 99/35831, hereinafter Schultheiss).

Regarding claim 23, the combination does not teach the following: recording means comprises a structure selected from the group consisting of: set top box, a computer system, satellite receiver, a cable receiver, an Internet television box, a network client, and a television.

However, Schultheiss discloses method and systems for providing television related services via networked personal computer which teaches the following: recording means comprises a

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structure selected from the group consisting of: set top box, a computer system, satellite receiver, a cable receiver, an Internet television box, a network client, and a television (fig. 1, page 8 line 18 to page 9 line 15).

Thus, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify the combination to provide for the following: recording means comprises a structure selected from the group consisting of: set top box, a computer system, satellite receiver, a cable receiver, an Internet television box, a network client, and a television as this arrangement would provide varied structure to control and record information as taught by Schultheiss, thus enhancing the usefulness of the system.

8. Claims 5, 15, and 24 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

(11) Response to Argument

Appellant's remarks have been fully considered but they are not persuasive.

1. With respect to Appellant's argument that office action must provide specific, objective evidence of record for a finding of a suggestion or motivation to combine reference teachings and must explain the reasoning by which the evidence is deemed to support such finding. Regarding this, office action dated 3-26-2003 has clearly identified motivation to combine the references and why one of ordinary skill in the art at the time invention was made would be motivated to apply teachings of the references to Appellant's claim limitations. However, Appellant would seem not to

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acknowledge this. Appellant's arguments on the first paragraph of page 7 of Appeal brief are noted, and they are not persuasive. Basically appellant attributes 35 U.S.C 103 rejections to hindsight and by this appellant has failed to acknowledge the teachings of the references and examiners reasons for combination based on teachings of the references and why one of ordinary skill in the art at the time invention was made would be motivated to apply teachings of the references to Appellant's claim limitations. Regarding Appellant's reference to hindsight, In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In response to appellant's bodily incorporation argument regarding 35 U.S.C 103 (a) obviousness rejection recited on first paragraph of page 7 of Appeal brief, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

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2. Rejection of claims 1-3, 12-13, 20-22, 27-30, 27-30 under 35 U.S.C 103(a) as being unpatentable over Lagoni et al. (US PAT: 6,141,058, hereinafter Lagoni) in view of Isaka (US PAT: 5,706,388) and Goldwasser et al. (US PAT: 5,241,428, hereinafter Goldwasser):

Regarding rejection of claims 1, 12, 13, 20-22, Appellant argues that there is no motivation or suggestion to combine Lagoni, Isaka and Goldwasser. In response to appellant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Lagoni teaches the following: a display capable of displaying caller identification data upon receipt of the call (col. 4 lines 4-9), a controller (110, fig. 1) capable of detecting acceptance and termination of the call by the user (col. 4 lines 10-17, also see step 530, fig. 5).

Regarding claims 12-13, and 20, Lagoni further discloses a system for providing uninterrupted viewing of a real time program during a telephone from a caller to a user, the system comprising: means for displaying caller identification information upon receipt of a call (col. 4 lines 4-9), means (110, fig. 1) for detecting acceptance and termination of the call by the user (col. 4 lines 10-17, also see step 530, fig. 5).

Regarding claims 21-22, Lagoni further discloses an integrated system for providing for providing uninterrupted viewing of a real time program during a telephone from a caller to a user,

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comprising: a display in (158, fig. 1) capable of displaying the program and caller identification information upon receipt of the call (col. 4 lines 4-9), a speaker (136, fig. 1) capable of audio output for the program and the call (51-53), a microphone (not shown) capable of accepting audio input for the call, a user input device (125, fig. 1) for controlling the viewing of the program (col. 4 lines 41-43, col. 5 lines 61-63) and for accepting and terminating the call, controller (110, fig. 1) capable of detecting and termination of the call by the user (this step is implicit in view of step 530 in fig. 5).

Lagoni differs from claims 1, 12, 13, 20-22 in that he does not teach the following: a buffer coupled to the controller, wherein the buffer is capable of buffering the real-time program from the acceptance of the call and providing buffered program to the user upon the termination of the call until the buffered program coincides with the real-time program.

However, Isaka discloses recording system which teaches the following: : a buffer coupled to the controller, wherein the buffer is capable of buffering the real-time program from the acceptance of the call and providing buffered program to the user upon the termination of the call (fig. 1, col. 3 lines 4-36) and Goldwasser discloses variable-delay recorder which teaches the following: providing buffered program to the user upon the termination of the call until the buffered program coincides with the real-time program.(col. 2 lines 65-68, col. 3 lines 1-5).

Therefore, in view of the teachings of the Isaka and Goldwasser, one of ordinary skill in the art at the time invention was made would be motivated to apply teachings of Isaka and Goldwasser in Lagoni as this arrangement would facilitate the user to accommodate temporary interruptions to the program being watched to take a telephone call and still catch up with the program after the

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telephone call is finished as taught by Isaka and Goldwasser, thus providing enhancements to the Lagoni's system.

Appellant further states that Examiner's statement regarding motivation to combine Lagoni, Isaka and Goldwasser is conclusory. With respect to this argument, Appellant's attention is drawn to the fact that both Isaka and Goldwasser discuss the receiving a telephone call when the user is watching a program. For instance, Isaka discusses the need for an arrangement for the users to store the television program currently being watched when there is incoming telephone call (col. 1 lines 21-26) and provides an arrangement for doing this (col. 3 lines 4-36). Similarly Goldwasser also discloses storing the program being watched to receive an incoming telephone call and catching up with the program once telephone call is completed (col. 2 lines 65-68, col. 3 lines 1-5). These teachings by Isaka and Goldwasser clearly provide ample foundation to use their teachings to modify Lagoni who also teaches user receiving telephone calls during the time when user is watching a television program.(fig. 4 col. 44-48) so that user can store currently watched program for accommodating a telephone call and catch with the television program after the telephone call as taught by Isaka and Goldwasser. Appellant further argues against individual references and this is not permissive. In response to appellant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Appellant further states that the examiner impermissibly uses current invention as a roadmap to make the combination of Lagoni and Goldwasser thus implying hindsight. In response to appellant's argument that the examiner's

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conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In the light of above explanation, a *prima facie* case of obviousness rejection has been made with respect to independent claims 1, 12, 13, 20 and 22 and corresponding dependent claims 2-3, 21 and 27-30, and the Board of Appeals is respectfully requested to uphold the rejection of these claims.

3. Rejection of claims 4, 6-9, 14, 16-19 under 35 U.S.C 103(a) as being unpatentable over Lagoni in view of Isaka and Goldwasser as applied to claim 1 above, and further in view of Natori et al. (JP02001028645A, hereinafter Natori):

Regarding rejection of claims 4, 6-9, 14, 16-19 under 35 U.S.C 103(a) as being unpatentable over Lagoni in view of Isaka and Goldwasser as applied to claim 1 above, and further in view of Natori, Appellant alleges that a *prima facie* case of obviousness has not been established because there is no suggestion to combine Lagoni, Isaka and Goldwasser and Appellant also alleges that *prima facie* case of obviousness has not been established because there is no suggestion to combine Natori with Lagoni, Isaka and Goldwasser.

I As already set forth above, a *prima facie* case of obviousness rejection has been made with respect to independent claims 1, 12, 13, 20 and 22 and corresponding dependent claims 2-3, 21 and

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27-30, based on Lagoni, Isaka and Goldwasser and also motivation to combine the references Lagoni, Isaka and Goldwasser is set forth above. Also the final office action also sets forth the reasons for combination Lagoni, Isaka and Goldwasser references and motivation to combine the references, contrary to Appellant's erroneous allegations otherwise. Therefore, *a prima facie* case of obviousness rejection has been set forth regarding independent claims 1, 12, 13, 20 and 22 and their dependent claims 2-3, 21 and 27-30.

II Regarding rejection of claims 4, 6-9, 14, 16-19, Appellant further alleges that there is no motivation to combine Natori with Lagoni, Isaka and Goldwasser and argues against the individual references. In response to appellant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Appellant further refers to response to arguments provided by the examiner in the final office action with respect to motivation to combine Natori with Lagoni, Isaka and Goldwasser and characterizes it as conclusory statements of the examiner. This final office action clearly sets forth the motivation to combine Natori with Lagoni, Isaka and Goldwasser and not conclusory statements erroneously alleged by appellant. For example final office action sets forth that Natori teaches storing history of telephone calls such as length of the telephone call, telephone number of the caller etc (see abstract) and further Natori states that this information can be used for (future) reference and the combination also teaches call related information such as telephone number of the caller, message of the caller can be stored, etc (col. 4 lines 19-32 of Lagoni). In light of this, one of ordinary skill in the art at the time invention

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was made would obviously be motivated to combine teachings of Natori with Lagoni, Isaka and Goldwasser as this arrangement would provide the caller with call history for referencing it when required by the user as taught by Natori, and further this practice is well known in the art as taught by Natori.

In the light of above explanation, a *prima facie* case of obviousness rejection has been made with respect to claims 4, 6-9, 14, 16-19, and the Board of Appeals is respectfully requested to uphold the rejection of these claims.

4. Rejection of claim 10 under 35 U.S.C 103(a) as being unpatentable over Lagoni in view of Isaka and Goldwasser as applied to claim 1 above, and further in view of Tsutsumi (JP406319173A):

1. Appellant alleges that there is no motivation to combine Lagoni in view of Isaka and Goldwasser.

Regarding this, motivation to combine Lagoni in view of Isaka and Goldwasser and motivation to combine the references is set forth above in item 1 under response to arguments (see page 9 of answer). Further final office action has provided objective evidence for a suggestion or motivation to combine Lagoni in view of Isaka and Goldwasser (first paragraph, page 4 final office action), contrary to Appellant's allegations otherwise.

5. Rejection of claim 11 under 35 U.S.C 103(a) as being unpatentable over Lagoni in view of Isaka and Goldwasser as applied to claim 1 above, and further in view of Lund (US PAT: 6,342,270 B1, filed 7-13-1998):

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1. Regarding rejection of claim 11, Appellant alleges that there is no motivation to combine Lagoni in view of Isaka and Goldwasser.

Regarding this, motivation to combine Lagoni in view of Isaka and Goldwasser and motivation to combine the references is set forth above in item 1 under response to arguments (see page 9 of answer). Further final office action has provided objective evidence for a suggestion or motivation to combine Lagon in view of Eustace and Goldwasser (first paragraph, page 4 final office action), contrary to Appellant's allegations otherwise.

6. Rejection of claims 25-26 under 35 U.S.C 103(a) as being unpatentable over Lagon in view of Eustace and Goldwasser as applied to claim 22 above, and further in view of Shimada et al. (JP403178247A, hereinafter Shimada) and Tamura et al. (JP404112374A, hereinafter Tamura):

1. Regarding rejection of claims 25-26, Appellant alleges that there is no motivation to combine Lagon in view of Eustace and Goldwasser.

Regarding this, motivation to combine Lagon in view of Eustace and Goldwasser and motivation to combine the references is set forth above in item 1 under response to arguments (see page 9 of answer). Further final office action has provided objective evidence for a suggestion or motivation to combine Lagon in view of Eustace and Goldwasser (first paragraph, page 4 final office action), contrary to Appellant's allegations otherwise.

7. Rejection of claim 23 under 35 U.S.C 103(a) as being unpatentable over Lagon in view of Eustace and Goldwasser as applied to claim 22 above, and further in view of Schultheiss et al. (WO 99/35831, hereinafter Schultheiss):

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1. Regarding rejection of claim 23, Appellant alleges that there is no motivation to combine Lagon in view of Eustace and Goldwasser.



Regarding this, motivation to combine Lagon in view of Eustace and Goldwasser and motivation to combine the references is set forth already in item 1 under response to arguments (see page 9 of answer). Further final office action has provided objective evidence for a suggestion or motivation to combine Lagon in view of Eustace and Goldwasser (first paragraph, page 4 final office action), contrary to Appellant's allegations otherwise.

Conclusion

For the above reasons, the examiner respectfully submits that a *prima facie* case of obviousness of the claimed invention has been set forth in the final office action and appellant(s) has/have failed to overcome the *prima facie* case of rejections. Accordingly, it is believed that the Final rejection under 35 U.S.C 103(a) is proper and Board of Patent Appeals and Interferences is therefore respectfully urged to affirm Examiner's rejection(s).

Respectfully submitted


CURTIS KUNTZ
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600


MELUR RAMAKRISHNAIAH
PRIMARY EXAMINER

JYNG CHAN
SENIOR PRIMARY EXAMINER
TECHNOLOGY CENTER 2600
conferee

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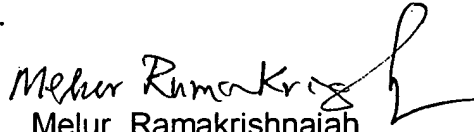
This is to inform the Appellant that a **SUPPLEMENTAL EXAMINER'S ANSWER** is provided along with English translations of Japanese references: JP 404112374A, JP403178247, JP406319173A, JP02001088545A. Also included here is a copy *f* Information Disclosure Statement (IDS) filed on April 4, 2004 (Paper No. 2) signed by the examiner, and which did not originally include examiner's signature inadvertently left out when originally mailed to the Appellant. There is no change in the rejections of the claims made originally in connection with examiner's answer (paper no 12).

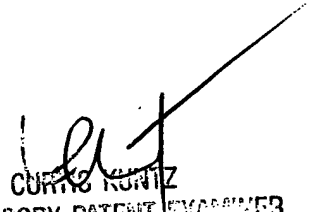
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melur Ramakrishnaiah whose telephone number is (703) 305-1461. The examiner can normally be reached on M-F 6:30-4:00; every other F Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Curtis Kuntz can be reached on (703)305-4708. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/042,428
Filing Date: October 24, 2001
Appellant(s): COOL, KENNETH J.

Bradley A. Forrest
For Appellant

EXAMINER'S ANSWER (SUPPLEMENTAL)

This is in response to the appeal brief filed 6-30-2003.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

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(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is deficient because it is not a summary of the appellant's invention, but rather a description of his drawings. The real summary of the invention is shown on pages 1 and 2 of the Appellant's specification and the Board's attention is respectfully directed to pages 1 and 2 of Appellant's specification for summary of the invention.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims Group 1: Claims 1-3, 10-13, 20-21, 22-23, and 25-30, the claims in this group do stand or fall together; Group 2: Claims

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4, 6-9, 14, 16-19, the claims in this group do stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

| | | |
|----------------|--------------------|---------|
| 6,141,058 | Lagoni, et al. | 10/2000 |
| 5,706,388 | Isaka | 1/1998 |
| 5,241,428 | Goldwasser et al. | 8/1993 |
| JP02001028645A | Natori et al. | 1/2001 |
| JP306319173A | Tsutsumi | 11/1994 |
| 6,324,270B1 | Lund | 11/2001 |
| JP403178247A | Shimada et al. | 8/1991 |
| JP404112374A | Tamura et al. | 4/1992 |
| wO 99/35831 | Schultheiss et al. | 7/1999 |

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

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the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-3, 12, 13, 20, 21, 22, 27-30, are rejected under 35 U.S.C. 103(a) as being unpatentable over Lagoni et al. (US PAT: 6,141,058, hereinafter Lagoni) in view of Isaka (US PAT: 5,706,388) and Goldwasser et al. (US PAT: 5,241,428, hereinafter Goldwasser).

Regarding claim 1, Lagoni discloses a system for uninterrupted viewing of a real time program during a telephone call to a user comprising: a display capable of displaying caller identification data upon receipt of the call (col. 4 lines 4-9), a controller (110, fig. 1) capable of detecting acceptance and termination of the call by the user (col. 4 lines 10-17, also see step 530, fig. 5).

Regarding claims 12-13, and 20, Lagoni further discloses a system for providing uninterrupted viewing of a real time program during a telephone call from a caller to a user, the system comprising: means for displaying caller identification information upon receipt of a call (col. 4 lines 4-9), means (110, fig. 1) for detecting acceptance and termination of the call by the user (col. 4 lines 10-17, also see step 530, fig. 5).

Regarding claims 21-22, Lagoni further discloses an integrated system for providing uninterrupted viewing of a real time program during a telephone from a caller to a user, comprising: a display in (158, fig. 1) capable of displaying the program and caller identification information upon receipt of the call (col. 4 lines 4-9), a speaker (136, fig. 1) capable of audio output for the program and the call (col. 2 lines 51-53), a

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microphone (not shown) capable of accepting audio input for the call, a user input device (125, fig. 1) for controlling the viewing of the program (col. 4 lines 41-43, col. 5 lines 61-63) and for accepting and terminating the call, controller (110, fig. 1) capable of detecting and termination of the call by the user (this step is implicit in view of step 530 in fig. 5).

Lagoni differs from claims 1, 12, 13, 20-22 in that he does not teach the following: a buffer coupled to the controller, wherein the buffer is capable of buffering the real-time program from the acceptance of the call and providing buffered program to the user upon the termination of the call until the buffered program coincides with the real-time program.

However, Isaka discloses recording system which teaches the following: a buffer coupled to the controller, wherein the buffer is capable of buffering the real-time program from the acceptance of the call and providing buffered program to the user upon the termination of the call (fig. 1, col. 3 lines 4-36) and Goldwasser discloses variable-delay recorder which teaches the following: providing buffered program to the user upon the termination of the call until the buffered program coincides with the real-time program.(col. 2 lines 65-68, col. 3 lines 1-5).

Thus, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify Lagoni's system to provide for the following: a buffer coupled to the controller, wherein the buffer is capable of buffering the real-time

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program from the acceptance of the call and providing buffered program to the user upon the termination of the call until the buffered program coincides with the real-time program as this arrangement would facilitate the user to accommodate temporary interruptions to the program being watched to take a telephone call and still catch up with the program after the telephone call is finished as taught by Isaka and Goldwasser, thus providing enhancements to the Lagoni's system.

Regarding claims 2-3, 27-30, Lagoni further teaches the following: display coupled to the buffer and further capable of displaying buffered program to the user (fig. 3, col. 4 lines 33-43), means (158, fig. 1) for displaying caller identification data from the incoming telephone call to assist the user in selecting whether to answer the incoming phone call, detecting means (110, fig. 1) further comprises displaying caller identification data from the incoming phone call when the caller identification data matches a predetermined list, the caller identification data displaying means otherwise not displaying the caller identification data, displaying caller identification data from the incoming phone call to assist the user in selecting whether to answer the incoming phone call, displaying caller identification data matches a predetermined list, the displaying means otherwise not displaying the caller identification data (fig. 5, col. 4 lines 55-67, col. 5 lines 1-18).

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3. Claim 4, 6-9, 14, 16-19, are rejected under 35 U.S.C. 103(a) as being unpatentable over Lagoni in view of Isaka and Goldwasser as applied to claim 1 above, and further in view of Natori et al. (JP02001028645A, hereinafter Natori)

Regarding claims 4 and 14, the combination teaches the following: a memory for storing data about the call, the data including the caller identification data about the call (col. 4 lines 64-67 of '058); but it does not teach storing the length of the call.

However, Natori discloses information device which teaches storing length of call (see abstract).

Thus, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify the combination to provide for storing length of call as this arrangement would provide call history for the user for referencing it when required as taught by Natori.

Regarding claims 6-9 and 16-19, the combination teaches the following: capable of storing a caller list, the caller list being generated based on the stored data about the call, caller included in the caller list if the stored data about the call indicates that at least a predetermined percentage of the caller's call were accepted by the user (this is implied by the priority caller list, note: col. 4 lines 19-32 of '058), caller identification is displayed only if the caller is included in the caller list, automatically accepting the call if the caller is included in the caller list (col. 2 lines 1-9 of '058).

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4. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lagoni in view of Isaka and Goldwasser as applied to claim 1 above, and further in view of Tsutsumi (JP406319173A).

Regarding claim 10, the combination does not explicitly teach the following: input device for controlling viewing of the program and for accepting and terminating the caller by the user.

However, Tsutsumi discloses a remote controller serving as a telephone set which teaches the following: input device (3, fig. 1) for controlling viewing of the program and for accepting and terminating the caller by the user (see abstract and paragraph: 0007).

Thus, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify the combination to provide for the following: input device for controlling viewing of the program and for accepting and terminating the caller by the user as this arrangement would enable the user to answer the call without going to the place of handset by using the remote controller as taught by Tsutsumi.

5. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lagoni in view of Isaka and Goldwasser as applied to claim 1 above, and further in view of Lund (US PAT: 6,342,270 B1, filed 7-13-1998).

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Regarding claim 11, the combination does not teach the following: controller is further capable of automatically muting audio associated with the program upon acceptance of the call by the user.

However, Lund discloses system and coordination of electronic devices which teaches the following: controller is further capable of automatically muting audio associated with the program upon acceptance of the call by the user (col. 2 lines 36-48).

Thus, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify the combination to provide for the following: controller is further capable of automatically muting audio associated with the program upon acceptance of the call by the user as this would enable the user to answer the telephone call without being distracted by television audio as taught by Lund.

6. Claims 25-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lagoni in view of Isaka and Goldwasser as applied to claim 22 above, and further in view of Shimada et al. (JP403178247A, hereinafter Shimada) and Tamura et al. (JP404112374A, hereinafter Tamura).

Regarding claims 25, the combination does not teach the following: voicemail system to handle incoming phone call in the event the user does not answer the incoming phone call.

However, Shimada discloses television communication equipment which teaches the following: voicemail system to handle incoming phone call in the event the user

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does not answer the incoming phone call (fig. 1, see the Implementation example on pages 9-12).

Regarding claim 26, the combination does not teach the following: voice mail system being disposed in a location selected from a group consisting of: integrated within the recording means, and external to recording means.

However, Shimada discloses voicemail system integrated with in the recording means (11, fig. 2, see the Implementation example on pages 9-12)) and Tamura teaches voicemail system external to the recording means in (11, fig. 1, and claim 1).

Thus, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify the combination to provide for the following: voicemail system to handle incoming phone call in the event the user does not answer the incoming phone call as this arrangement would facilitate to record messages when user is unable to answer the call as taught by Shimada; voice mail system being disposed in a location selected from a group consisting of: integrated within the recording means, and external to recording means as this arrangement would facilitate storage facilities for messages at different locations to suite users requirements when the user is unable to answer the call as taught by Shimada and Tamura.

7. Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lagoni in view of Isaka and Goldwasser as applied to claim 22 above, and further in view of Schultheiss et al. (WO 99/35831, hereinafter Schultheiss).

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Regarding claim 23, the combination does not teach the following: recording means comprises a structure selected from the group consisting of: set top box, a computer system, satellite receiver, a cable receiver, an Internet television box, a network client, and a television.

However, Schultheiss discloses method and systems for providing television related services via networked personal computer which teaches the following: recording means comprises a structure selected from the group consisting of: set top box, a computer system, satellite receiver, a cable receiver, an Internet television box, a network client, and a television (fig. 1, page 8 line 18 to page 9 line 15).

Thus, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify the combination to provide for the following: recording means comprises a structure selected from the group consisting of: set top box, a computer system, satellite receiver, a cable receiver, an Internet television box, a network client, and a television as this arrangement would provide varied structure to control and record information as taught by Schultheiss, thus enhancing the usefulness of the system.

8. Claims 5, 15, and 24 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

(11) Response to Argument

Appellant's remarks have been fully considered but they are not persuasive.

1. With respect to Appellant's argument that office action must provide specific, objective evidence of record for a finding of a suggestion or motivation to combine reference teachings and must explain the reasoning by which the evidence is deemed to support such finding. Regarding this, office action dated 3-26-2003 has clearly identified motivation to combine the references and why one of ordinary skill in the art at the time invention was made would be motivated to apply teachings of the references to Appellant's claim limitations. However, Appellant would seem not to acknowledge it. Appellant's arguments on the first paragraph of page 7 of Appeal Brief are noted, and they are not persuasive. Basically Appellant attributes 35 U.S.C rejections to hindsight and by this, Appellant has failed to acknowledge the teachings of the references and examiners reasons for combination based on teachings of the references and why one of ordinary skill in the art at the time invention was made would be motivated to apply teachings of the references to Appellant's claim limitations. Regarding Appellant's reference to hindsight, In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In response to Appellant's bodily incorporation argument regarding 35 U.S.C 103(a) obviousness rejection recited on first paragraph of Appeal brief, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

2. Rejection of claims 1-3, 12, 13, 20, 21, 22, 27-30, under 35 U.S.C. 103(a) as being unpatentable over Lagoni et al. (US PAT: 6,141,058, hereinafter Lagoni) in view of Isaka (US PAT: 5,706,388) and Goldwasser et al. (US PAT: 5,241,428, hereinafter Goldwasser):

Regarding rejection of claims 1,12, 13, 20-22, Appellant argues that there is no motivation or suggestion to combine Lagoni, Isaka and Goldwasser. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Lagoni teaches the following: a display capable of displaying caller identification data upon receipt of the call (col. 4 lines 4-9), a controller (110, fig. 1) capable of detecting acceptance and termination of the call by the user (col. 4 lines 10-17, also step 530, fig. 5).

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Regarding claims 12-13, and 20, Lagoni further discloses a system for providing uninterrupted viewing of a real-time program during a telephone call from a caller to a user, comprising: means for displaying caller identification information upon receipt of a call (col. 4 lines 4-9), means (110, fig. 1) for detecting acceptance and termination of the call by the user (col. 4 lines 10-17, and also see step 530, fig. 5).

Regarding claims 21-22, Lagoni further discloses an integrated system for providing uninterrupted viewing of real time program during a telephone call from a caller to a user, comprising: a display in (158, fig. 1) capable of displaying the program and caller identification information upon receipt of the call (col. 4 lines 4-9), a speaker (136, fig. 1) capable of audio output for the program and the call (col. 2 lines 51-53), a microphone (not shown) capable of accepting audio input for the call, a user input device (125, fig. 1) for controlling the viewing of the program (col. 4 lines 41-43, col. 5 lines 61-63) and for accepting and terminating the call, the controller (110, fig. 1) capable of detecting and termination of the call by the user (this step is implicit in view of step 530 in fig. 5).

Lagoni differs from claims 1, 12, 13, 20-22 in that he does not teach the following: a buffer coupled to the controller, wherein the buffer is capable of buffering the real-time program from the acceptance of the call and providing buffered program to the user upon the termination of the call until the buffered program coincides with the real-time program.

However, Isaka discloses recording system which teaches the following: a buffer coupled to the controller, wherein the buffer is capable of buffering the real-time program from the acceptance of the call and providing buffered program to the user upon the

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termination of the call (fig. 1, col. 3 lines 4-36) and Goldwasser discloses variable-delay recorder which teaches the following: providing buffered program to the user upon the termination of the call until the buffered program coincides with the real-time program.(col. 2 lines 65-68, col. 3 lines 1-5).

Therefore, in view of the teachings of the Isaka and Goldwasser, one of ordinary skill in the art at the time invention was made would be motivated to apply teachings of Isaka and Goldwasser in Lagoni as this arrangement would facilitate the user to accommodate temporary interruptions to the program being watched to take a telephone call and still catch up with the program after the telephone call is finished as taught by Isaka and Goldwasser, thus providing enhancements to the Lagoni's system.

Appellant further states that Examiner's statement regarding motivation to combine Lagoni, Isaka and Goldwasser is conclusory, with respect this argument, Appellant's attention is drawn to the fact that both Isaka and Goldwasser discuss the receiving telephone call when the user is watching a program. For instance, Isaka discusses the need for an arrangement for the users to store the television program currently being watched when there is incoming telephone call (col. 1 lines 21-26) and provides an arrangement for doing this (col. 3 lines 4-36). Similarly Goldwasser also discloses storing the program being watched to receive an incoming telephone call and catching up with the program once telephone call is completed (col. 2 lines 65-68, col. 3 lines 1-5). These teachings by Isaka and Goldwasser clearly provide an ample motivation to use their teachings to modify Lagoni who also teaches user receiving telephone calls during the time when user is watching a television program (fig. 4 col. 4 lines 44-48) so that user can store currently watched program for accommodating a

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telephone call and catch with the television program after the telephone call as taught by Isaka and Goldwasser. Appellant further argues against individual references and this is not permissive. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Appellant further states that the examiner impermissibly uses current invention as a roadmap to make the combination of Lagoni, Isaka and Goldwasser thus implying hindsight. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In light of the above explanation, a *prima facie* case of obviousness rejection has been made with respect to independent claims 1, 12, 13, 20 and 22 and corresponding dependent claims 2-3, 21 and 27-30, and the Board of patent appeals and Interferences is respectfully requested to uphold rejection of these claims.

3. Rejection of claims 4, 6-9, 14, 16-19 under 35 U.S.C. 103(a) as being unpatentable over Lagoni in view of Isaka and Goldwasser as applied to claim 1 above, and further in view of Natori et al. (JP02001-028645A, hereinafter Natori):

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Regarding rejection of claims 4, 6-9, 14, 16-19 under 35 U.S.C 103(a) as being unpatentable over Lagoni in view of Isaka and Goldwasser as applied to claim 1 above and further in view of Natori, Appellant alleges that a *prima facie* case of obviousness has not been established because there is no suggestion to combine Lagoni, Isaka and Goldwasser and Appellant also alleges a *prima facie* case of obviousness has not been established because there is no suggestion to combine Natori with Lagoni, Isaka and Goldwasser.

I As already set forth above, a *prima facie* case of obviousness rejection has been made with respect to independent claims 1, 12, 13, 20 and 22 and corresponding dependent claims 2-3, 21, and 27-30, based on Lagoni, Isaka and Goldwasser and also motivation to combine references Lagoni, Isaka and Goldwasser is set forth above. Also the final office action sets forth the reasons for combination of Lagoni, Isaka and Goldwasser references and motivation to combine the references, contrary to Appellant's erroneous allegations otherwise. Therefore, a *prima facie* case of obviousness rejection has been set forth regarding independent claims 1, 12, 13, 20 and 22, and their dependent claims 2-3, 21 and 27-30.

II Regarding rejection of claims 4, 6-9, 14, 16-19, Appellant further alleges that there is no motivation to combine Natori with Lagoni, Isaka and Goldwasser and argues against references. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Appellant further refers to response to arguments provided

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by the examiner in the final office action with respect to motivation to combine Natori with Lagoni, Isaka and Goldwasser and characterizes it as conclusory statements of the examiner. The final office action clearly sets forth the motivations to combine Natori with Lagoni, Isaka and Goldwasser and they are not conclusory statements erroneously alleged by the appellant. For example final office action sets forth that Natori teaches storing history of telephone calls such as length of the telephone call, the telephone number of the caller etc (see abstract) and further Natori states that this information can be used for (future) reference and the combination also teaches call related information such a telephone number of the caller, message of the caller can be stored, etc (col. 4 lines 19-32 of Lagoni). In light of this, one of ordinary skill in the art at the time invention was made would be obviously motivated to combine teachings of Natori with Lagoni, Isaka and Goldwasser as this arrangement would provide the caller with call history for referencing it when required as taught by Natori, and further this practice is well known in the art as taught by Natori.

In light of above explanations, a *prima facie* case of obviousness rejection has been made with respect to claims 4, 6-9, 14, 16-19, and the Board of Appeals and Interferences is respectfully requested to uphold the rejection of these claims.

4. Rejection of claim 10 under 35 U.S.C 103(a) as being unpatentable Lagoni in view of Isaka and Goldwasser as applied to claim 1 above, and further in view of Tsutsumi (JP06-319173):

1. Appellant alleges that there is no motivation to combine Lagoni in view of Isaka and Goldwasser.

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Regarding this, motivation to combine Lagoni in view of Isaka and Goldwasser and motivation to combine the references is set forth in item 1 under response to arguments (see page 9 of answer). Further final office action has provided objective evidence for a suggestion or motivation to combine Lagoni in view of Isaka and Goldwasser (first paragraph, page 5 of final office action), contrary to Appellant's allegations otherwise.

5. Rejection of claim 11 under 35 U.S.C 103(a) as being unpatentable over Lagoni in view of Isaka and Goldwasser as applied to claim 1 above, and further in view of LUND (US PAT: 56,342,270 B1, filed 7-13-1999):

1. Regarding rejection of claim 11, Appellant alleges that there is no motivation to combine Lagoni in view of Isaka and Goldwasser and motivation to combine the references is set forth above in item 1 under response to arguments (see page 9 of answer). Further final office action has provided objective evidence for suggestion or motivation to combine Lagoni in view of Isaka and Goldwasser (pages 6-7 of final office action), contrary to Appellant's allegations otherwise.

6. Rejection of claims 25-26 under 35 U.S.C 103(a) as being unpatentable over Lagoni in view of Isaka and Goldwasser as applied to claim 22 above, and further in view of Shimada et al. (JP403178247A, hereinafter Shimada) and Tamura et al. (JP404112374A, hereinafter Tamura):

1. Regarding rejection of claims 25-26, Appellant alleges that there is no motivation to combine Lagoni in view of Isaka and Goldwasser.

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Regarding this, motivation to combine Lagoni in view of Isaka and Goldwasser and motivation to combine the references is set forth above in item 1 under response to arguments (see page 10 of the answer). Further final office action has provided objective evidence for suggestion or motivation to combine Lagoni in view of Isaka and Goldwasser (page 7 of final office action), contrary to Appellant's allegations otherwise.

7. Rejection of claim 23 under 35 U.S.C 103(a) as being unpatentable over Lagoni in view of Isaka and Goldwasser as applied to claim 22 above, and further in view of Schultheiss et al. (WO 99/35831, hereinafter Schultheiss):

1. Regarding rejection of claim 23, Appellant alleges that there is no motivation to Lagoni in view of Isaka and Goldwasser.

Regarding this, motivation to combine Lagoni in view of Isaka and Goldwasser and motivation to combine the references is set forth already in item 1 under response to arguments (see page 11 of answer). Further final office action has provided objective evidence for a suggestion or motivation to combine to combine Lagoni in view of Isaka and Goldwasser (page 8 of final office action, contrary to Appellanr's allegations otherwise.

Conclusion

For the above reasons, the examiner respectfully submits that a *prima facie* case of obviousness of the claimed invention has been set forth in the final office action and appellant(s) has/have failed to overcome the *prima facie* case of rejections.


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Accordingly, it is believed that the Final rejection under 35 U.S.C is proper and Board of Patent Appeals and Interferences is therefore respectfully urged to affirm Examiner's rejection(s).


Respectfully submitted



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